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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/844,322

04/26/2001

Casey William Norman

1391-CON-00

1969

7590

02/04/2003

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1600 Market Street, Suite 3600  
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EXAMINER

FRANCIS, FAYE

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-23 and 25-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 25-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20-23, 25-32 and 47-51 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda.

Yasuda discloses a seamless [Fig 1] doll's garment [col 19, 2<sup>nd</sup> line from the bottom] formed from an injection molded [col 5 line 42] thermoplastic [claim 8] elastomer as recited in claims 21, 22 and 47, wherein the thermoplastic elastomer is containing styrene [col 3 lines 18-54] as recited in claims 20 and 47 and the garment includes a detail/ribbon [col 19 last line] as recited in claims 23, 29, 48 and 49, the colorless injected molded thermoplastic elastomer transparent, col 4 line 6] as recited in claim 27, but does not disclose the garment has a wall thickness from 1 to 3 mm as recited in claims 20-21 and 47, the thermoplastic elastomer has an average modulus of elasticity of less than 1 MN/m<sup>2</sup> as recited in claims 22 and 30-32, 47 and 50-51, a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 26 and the garment is less than 8 cm in height as recited in claim 28.

Moreover the limitations in claims 25 and 49 are presumed to be inherent in the device of Yasuda [col 19 last paragraph and col 20 first paragraph].

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With respect to claims 20-21 and 47, it would have been obvious to provide the garment of Yasuda in the claimed thickness for the purpose of making the devices easier to play with.

With respect to claims 22 and 30-32, 47 and 50-51, it would have been obvious to construct the device of Yasuda to have the claimed average modulus of elasticity for the purpose of having good elasticity and deformability.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to modify the Yasuda's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

With respect to claim 28, it would have been obvious to provide the garment of Yasuda in the claimed height for the purpose of making the devices easier to play with.

3. Claims 33-46 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yasuda in view of Gross.

Yasuda discloses most of the features of these claims as disclosed above in paragraph 4, but does not disclose a play set comprising a doll as recited in claims 33 and 38 wherein doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips as recited in claims 34 and 38, the garment has a wall thickness from 1 to 3 mm as recited in claims 33 and 38, the thermoplastic elastomer has an average modulus of elasticity of less than 1 MN/m<sup>2</sup> as recited in claims 38 and 41-43, a plurality of seamless garments as recited in claim 44 and a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 46.

Gross is cited to show a desirability to have a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees. It would have been obvious to provide the device of Yasuda with the doll disclosed by Gross, for the purpose of making the device more enjoyable for the children to play with by having a complete set [doll and the doll's garment].

With respect to claims 33 and 38, it would have been obvious to provide the garment of Yasuda in the claimed thickness for the purpose of making the devices easier to play with.

With respect to claims 38 and 41-43, it would have been obvious to construct the device of Yasuda to have the claimed average modulus of elasticity for the purpose of having good elasticity and deformability.

With respect to claim 46: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to modify the Yasuda's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

#### ***Response to Arguments***

4. Applicant's arguments filed 10/15/02 have been fully considered but they are not persuasive.

The rejection under 35 U.S.C. 112, second paragraph on the ground that claim 47 is indefinite has been withdrawn. The rejection was based on the fact that the claim appeared to recite further limitations on the doll when no doll appear to have been positively recited therein claims or in any claim from which it depended. However, based

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on the amendments made to the claims in response to the office action, the rejection is no longer applicable.

As to the Declaration under Rule 131, the examiner responds as follows,

In response to applicant's argument on page 5 that clear evidence of conception of the invention -- injection molded thermoplastic elastomeric doll's clothing -- has been proven, the examiner would like to point out that the allegation that the inventors ordered a flexible model and a rigid model for development of an injection mold, at least as early as March 1997 does not provide clear evidence of conception of the invention prior to the filing date of Yasuda's March 28, 1997. In the contrary, this argument appears to imply that the production of injection molded thermoplastic elastomeric doll's clothing was still in developmental stage prior to the filing date of Yasuda.

Also, applicants by their own admission continued to perform substantial experimentation. For example, applicants have stated on page 5 that the injection mold itself, from which the thermoplastic clothing was made, was not available until April or May of 1997, and that once the injection mold was available, effort was immediately made to find the optimal material. Furthermore, the applicant did not provide any proof as to the above allegation.

In another example, in a Fax dated 3/24/97, Mr. Norman indicated that although Gamlin has difficulty with the materials he is working with (they get harder after a day or two), improvement is needed for the doll's clothing so that they must be easy to put on and take off. Additionally, Mr. Norman indicated in the same Fax that they are going to need help and experimentation on the engineering.

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All of the above examples are clear indication that the applicants were still experimenting with the material. Additionally, the applicant fail to provide any proof that thermoplastic elastomeric including KLRATON were tested immediately thus, clarifying the reduction to practice of the invention and to provide any result of alleged testing in Hong Kong.

In response to the allegation on page 2 first paragraph that it was known to the applicant that injection molding would be the only financially acceptable method of production, and that the clothing would necessarily be injection molded from a material having elasticity similar to the modeling polyurethane that is, a thermoplastic elastomer. The examiner would like to point out that there is no evidence supporting this allegation that the applicants in fact had the knowledge prior to Yasuda's March 28, 1997 filing date.

In response to the allegation on page 2 third paragraph that flexible and rigid models were ordered at least as early as March 1997 for use in preparing the injection molds, the examiner would like to point out that again there is no evidence [invoice] indicating that models were indeed ordered prior to Yasuda's March 28, 1997 filing date.

Moreover the applicants alleged that the testing began immediately at their Hong Kong facility once the molds were available. However, as stated before the applicants fail to provide any result from alleged testing. Additionally, this is a further proof that the applicants were still experimenting at that time with the material.

It is noted that the applicant had shown documents relating the need for the ease of fit. However, it is not clear when the applicants have had arrived to their invention [the particular doll's garment in the claims]?

For the reasons above the evidence presented is insufficient to remove the rejection under 35 U.S.C. 103(a) and the applicant's invention does not antedates the Yasuda's reference.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for

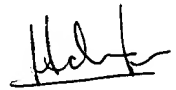


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the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

FF  
January 28, 2003

A handwritten signature in black ink, appearing to be "Holt", written over a horizontal line.